

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUAKI WATANABE,
SHINICHI KATO AND
BUNJI ISHIMOTO

Appeal No. 2005-1629
Application No. 10/001,256

HEARD: MARCH 23, 2006

MAILED
JUL 28 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WARREN, WALTZ, and FRANKLIN, *Administrative Patent Judges*.
WALTZ, *Administrative Patent Judge*.

REQUEST FOR REHEARING

This is a decision on appellants' Request for Rehearing (hereafter "Request") dated May 30, 2006, submitted under the provisions of 37 CFR § 41.52 (2005), where appellants request rehearing of the merits panel Decision dated March 30, 2006 (hereafter the "Decision"). The Decision affirmed the examiner's rejections of claims 1, 3 and 8 through 10 under 35 U.S.C. § 103(a) as unpatentable over JP '525 or Anton, each in view of Sano (Decision, page 3).

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Appellants request rehearing based on four issues, labeled as I, II, III and IV on pages 2-7 of the Request. We do not find appellants' arguments regarding these issues to be persuasive of error in our Decision. We present our reasoning in support of this determination below, treating each issue in the order presented in the Request.

With regard to issue I, appellants argue that the Board has misapprehended the teachings in Sano, "which do **not** suggest that the subject penetrating agent is useful for other ink compositions" but rather is specifically directed to alginate-containing ink compositions (Request, pages 2-3, citing Sano, col. 4, ll. 24-29, and col. 7, ll. 21-36). This is the identical argument presented by appellants in their Brief, Reply Brief, and Supplemental Reply Brief (see the sentence bridging pages 5 and 6 of the Decision), and we incorporate our response from the Decision (pages 6-8). Appellants have not argued or disputed the rationale espoused in our Decision, namely that Sano teaches the balancing or trade-off of properties for all additives, especially penetrants, in ink compositions (*id.*). We further note that appellants have cited but not disputed the teaching of Sano that penetrating agents were used before in certain critical concentrations to attain enhanced penetrating power that lessens

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color bleeding, but with the use of alginates it is not necessary that the penetrating power be raised as high as for conventional ink compositions (Decision, page 7, citing Sano, col. 7, ll. 21-36). This teaching of Sano would have clearly led one of ordinary skill in the art to use the penetrants taught by Sano in conventional ink compositions, varying the amounts to obtain any desired properties.¹ We have also noted that the claims on appeal are not limited to any specific amount of "ultra-penetrating agent" (Decision, page 8, footnote 4). Accordingly, we have determined that it would have been obvious to one of ordinary skill in this art at the time of appellants' invention to have used the penetrating agents taught as preferred by Sano in place of common penetrants in conventional ink compositions, with the amount of penetrating agent needed readily determined by the artisan depending on the properties desired (Decision, pages 7-8).

With respect to issue II, appellants argue that, in light of Anton's teaching that the type of surfactant must be carefully

¹We note that Sano tests the claimed penetrating agent in inks without alginates, with results similar in most examples to inks with alginates (see the comparative examples at col. 17, ll. 52-65, and Table 1). We also note that these non-alginate containing inks were tested with the low amounts of the claimed penetrant used in the corresponding examples of Sano.

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selected to avoid negative effects, there could be no motivation for one of skill in the art to select a type of surfactant from Sano (Request, page 4). This argument is not persuasive for the same reasons as discussed above and in the Decision at pages 6-8, namely that any use of a surfactant/penetrant involves a balancing or trade-off of properties such as enhanced color vs. lessening color bleeding. Anton at col. 8, ll. 40-46, merely teaches a similar balancing of properties as taught by Sano. Furthermore, as discussed above and in the Decision (page 8), the amount of penetrant used will greatly influence the desired properties.

With regard to issue III, appellants argue that Sano describes the claimed penetrating agent as being preferred only for alginate-containing inks, and thus there would have been no expectation of improved results for other ink compositions (Request, page 5). Additionally, appellants argue that even if the expectation of improved properties extended to other ink compositions, there was no expectation of advantageous properties such as improved cohesion differential, gloss differential, glossiness, and ejection stability (*id.*, citing the Watanabe Declaration filed Nov. 10, 2003).

Regarding appellants' first argument, we adopt our remarks from the Decision and above concerning the use of the preferred penetrant taught by Sano as not limited to alginate-containing inks, but the use of the claimed penetrant in conventional (or non-alginate containing) inks would have been obvious to one of ordinary skill in this art. With regard to appellants' argument concerning the specific properties tested in the Watanabe Declaration, we note that Sano tests for many desired properties (col. 16, l. 36-col. 18, l. 29), some of which are the same or similar to the properties found in the Watanabe Declaration (e.g., "stably jetted" at col. 18, l. 49, as well as "head clogging" at col. 17, ll. 7-23, vs. ejection stability in the Declaration (see the specification, page 35); "feathering" of the print at col. 16, ll. 36-52, and color bleeding at col. 16, ll. 53-67, which we assume is similar to the "cohesion differential" shown in the Declaration).² The glossiness properties tested for in the Declaration would have been expected from the use of the preferred surfactant (penetrant) taught by Sano, even though not described per se, since a surfactant would have been expected to increase the surface active properties of any ink composition.

² The "cohesion differential" was never defined in the specification (pages 32-33) or the Watanabe Declaration.

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Regardless, the discovery of a property inherent to a composition cannot be the basis for patentability. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

With regard to issue IV, appellants argue that the two findings raised by the Board with respect to the evidence "were not raised in the prosecution of this application or in the Examiner's Answer and thus constitute new ground(s) for rejection" (Request, page 7, citing *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995)). This argument is not persuasive for several reasons. First, we note that the examiner's reliance on the finding that the improved results would have been expected from the teachings of Sano alone would be sufficient to rebut appellants' showing of evidence. See *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975) (Decision, page 9). Secondly, the burden is on appellants to establish that the submitted comparative evidence is commensurate in scope with the claimed subject matter, the comparison is with the closest prior art, and there is only one variable whose cause and effect is sought to be shown. See *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972); *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Int. 1992). Whether or not the examiner finds that the comparative

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evidence is not persuasive for any reason, the appellants still have the burden of establishing that the showing is with the closest prior art, commensurate in scope with the subject matter sought to be patented, and that the results are truly unexpected. Appellants have had ample opportunity to meet this burden. Third, the citation of *In re Soni* is not controlling here since the court in *Soni* held that new rationales or arguments cannot be made on appeal to the Federal Circuit (54 F.3d at 751, 34 USPQ2d at 1688). Furthermore, our Decision has no new "rationale" but merely finds additional deficiencies in appellants' rebuttal evidence.

For the foregoing reasons and those stated in the Decision, we find no error in fact or law in the Decision. Furthermore, we do not find any cause for a new ground of rejection. Accordingly, we have considered appellants' Request for Rehearing and such Request is denied.

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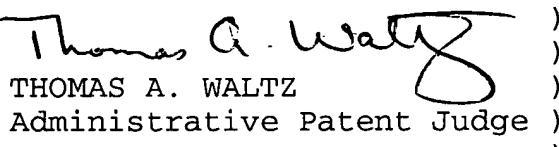
No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

DENIED



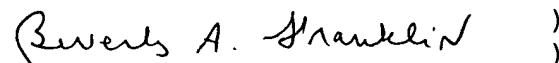
CHARLES F. WARREN)
Administrative Patent Judge)

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THOMAS A. WALTZ)
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